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This communication is in response to the Office Action with the mailing date of June 23, 2003 regarding application number 09/634,612.

The Examiner's comment that the amendment filed on April 15, 2003 "is sufficient to overcome the Bucci (5,655,089) reference" is so noted, as are the Examiner's comments relating to the Election/Restriction of the Amendment.

The Applicant will address points raised by the Examiner. In addition to the underlining of patents referenced, relevant aspects of cited passages to be discussed will be underlined as well. The Applicant will also italicize words or phrases he considers key.

On page 5 of the Office Action:

"12. Claims 60-99 and 103-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucci (5,655,089) in view of Byerly et al. (6,067,524)."

The Applicant wishes to provide his interpretation and commentary on each of the two cited references. First, on Bucci:

Using the wording of the sole independent claim of Bucci, Bucci teaches:

"A method for the consolidation, summarization and transmission of a plurality of available materials by a plurality of differing, non-related subscribers transmitting to a plurality of end users, comprising the steps of:  
forming an information database in a computer as to the identities of intended end users of each non-related subscriber;  
inputting individual information into the computer as to bills, statements, records, advertising and other written communications from each said non-related subscriber for each said identified end user during a given period of time;  
accumulating a plurality of said input informations of bills, statements, records, advertising and other written communications from each said non-related subscriber, and sorting said accumulated input informations by each said identified end user;  
developing at least one page of said sorted accumulated input informations for each said end user identified to receive said sorted accumulated input informations; and,

sending said page of sorted accumulated informations from said plurality of non-related subscribers to said individual identified end user to receive said page as a single, unitized transmission of all informations intended for said identified end user.”

Dependent claims have also been considered in the Applicant's observations that will now be discussed.

- The initiator, or the party that enlists the services of the Bucci method, is the subscriber, not the end user as alluded to by the Examiner at the bottom of page 5 and the top of page 6 in the referenced Office Action. According to Bucci, potential subscribers comprise “such businesses as American Express, AT&T, Blue Cross/Blue Shield, Sears, and Merrill Lynch” that “send out monthly statements to their customers each month” (column 3, lines 34-36).
- Unlike the Applicant's disclosure, there are no end user prompts, nor are there any end user prompts comprising an end user permission step in Bucci (in the Applicant's method, the end user prompt comprising the end user permission step is either where the end user opens the financial card account, or expresses a desire to receive health reminders after an account has been opened). In the Applicant's reading of Bucci, the end user is merely a passive participant that has no disclosed recourse whatsoever for supplying preference information regarding the materials that he wishes to receive, nor can the end user grant or deny permission to have his bills consolidated. The end user basically gets his bills consolidated whether he wants it or not, being that the service disclosed in Bucci is requested by the varied subscribers, and not the varied end users.
- On page 6 of the Office Action with regards to Bucci, the Examiner states, “it would have been obvious to one having ordinary skill in the art at the time the invention was made to prompt the end user to provide the information...” The Applicant respectfully questions whether it is fair to infer that Bucci comprises steps to “prompt the end user” when in fact there is no such basis in Bucci. As mentioned earlier, Bucci does not comprise end user prompts in any manner whatsoever, including prompts used to obtain end user preferences, or even end user permission to participate in the method; instead, the varied subscribers supply any such end user

information. Although one with “ordinary skill in the art” could surmise that a method such as Bucci could make use of end user prompts, the Applicant contends that idealizing or modifying Bucci in such a manner is *potentially damaging* to Bucci, and also runs the risk of putting Bucci himself in a light that he may not desire, especially since his method is highly functional *without* the use of end user prompts, or without the use of an end user permission step. One should realize that including a permission step could wreak havoc on those subscribers that wish to have their respective end users rely totally on the solution that Bucci provides; in these cases, having a permission step burdens the subscribers with the expense and hassle of finding alternatives for end users that choose to opt out of the Bucci method, and makes the overall situation intensely more complicated for all of the concerned parties. Much more often than not, an end user that has no additional options will settle for what is offered, even if it is done without his expressed consent. To paraphrase an old Navy Officer, it is often better to take action and risk having to apologize later than to ask permission first.

- The Examiner makes reference on page 5 of the Office Action “b. Providing one or more targeted messages to the end user (column 3, lines 51-59)”. Lines 51-59 in Bucci are as follows:

“At the same time, the Universal Mail system can be used to create a large data base of consumer buying patterns, which can be used for targeted marketing, or for additional marketing by geographic areas. In similar fashion, other hard-copy material can be included in the single envelope carrying the one-page, or more, summary of all billing statements, to carry, as well, other hard-copy materials in the nature of advertising or bill breakdown information.”

With great respect to the Examiner, the Applicant finds the Examiner’s phrase “b. Providing one or more targeted messages to the end user” to be confusing in this context. While “targeted marketing” appears in the cited Bucci reference, the Applicant can find no mention of the term “targeted messages” anywhere in the quoted reference, or anywhere else in Bucci. Generally speaking, “targeted marketing” is an “old and well known” term comprising the use of advertising that is aimed at a particular group or demographic. This, especially in light of Bucci’s disclosure of “other hard-copy materials in the nature of advertising or bill breakdown

information” in the same referenced section, lends weight to an argument that the targeted marketing that Bucci refers to is “in the nature of advertising”, and *not* to targeted messages.

- Bucci makes references to “other written communications from each said non-related subscriber” (column 4, lines 18-19). In the case of the Applicant’s disclosure, the communications from an issuing financial card entity to an end user in order to disseminate health reminders, tips, or suggestions are paramount. The difference is in the curveball. Nowhere in Bucci is the disclosure of “other written communications from each said non-related subscriber” exemplified or suggested as being anything out of the ordinary. For example, in Bucci, communications from a subscriber that is a telephone company can be reasonably expected to comprise items relating to telephone services, whereas communications from a financial card issuer can be reasonably expected to comprise items relating to financial card matters; this observation is expressly due to the fact that Bucci, in no way, shape, or form, makes any allusion or reference to the contrary. The novelty inherent in the Applicant’s disclosure has to do with the fact that health reminders are old and well known, and that financial cards and related financial card accounts whose primary functions have nothing to do with health related matters are also old and well known, and combining or linking the two is a total curveball, being that no ordinary motivation exists to combine the two. In Bucci, “other written communications” are not disclosed as being anything unusual, so it would not be a reach to conclude that they are meant to be congruous, while the Applicant takes pains to point out that the communications of the Applicant’s disclosure are highly incongruous, in that having a financial card statement comprising use of a health reminder is incongruous, and even considering the converse, where having a health reminder comprising use of financial card information, where the underlying financial card comprising the financial card information serves a primary function of enabling commerce that has nothing to do with health related matters. For the record, the Applicant considers other aspects of his disclosure to be incongruous: one would not expect an entity whose primary function is financial cards, where the primary purpose of the financial cards has nothing to do with health, to be an issuer of health reminders; one would not expect

an entity whose primary function is not health, and whose non-primary function is financial cards, again where the primary purpose of the financial cards has nothing to do with health, to have a health reminder feature tied in with the financial card; one would not expect an entity whose primary function is health, and whose non-primary function is financial cards, again where the primary purpose of the financial cards has nothing to do with health, to have a health reminder feature tied in with the financial card, although they could offer health reminders and financial cards separately, with no ties or other contingencies between the two, (if the two were combined, the Applicant would consider that as reading on his disclosure). Other aspects deemed incongruous is an application for a card account that is tied in any way with an application for a health reminder (and vice-versa, where an application for a health reminder service is tied in any way with an application for a card account), and an end user file that comprises financial card account information that is tied in any way with any form of a health reminder file (and vice versa, where an application for a health reminder service is tied in any way with financial card account information). Separate a financial card account and its associated financial card from a health reminder account in every way, thereby totally eliminating any and all incongruity, and you have eliminated the novelty as well. Being that financial cards/accounts are old and well known, and being that health reminders are also old and well known in their own right, and that each of the two has done an outstanding job of existing in absence of the other over time, there is no novelty in having financial card services that perform only financial card services, nor is there any novelty in having a health reminder that acts only as a health reminder. Reintroduce any of the incongruity whatsoever by combining or linking the two in any way, even if it's only the slightest bit of commonality (such as a linked application stage), and you restore novelty that reads on the Applicant's disclosure.

At this time, the Applicant wishes to provide his commentary on Byerly et al:

Using the wording of the first four method claims (subsequent claims are for system and computer program product claims) of Byerly et al, Byerly et al is as follows:

“What is claimed as new and desired to be secured by Letters Patent of the United States is:

1. A method for generating advisory messages to pharmacy patients, said method comprising the steps of:
  - (a) appending patient-specific information to a data record:
    - (i) containing normally transmitted information
    - (ii) transmitted between a third party computer and a pharmacy computer during a pharmacy transaction;
  - (b) capturing the data record transmitted to the pharmacy computer as the data record is received by the pharmacy computer or after the data record is transmitted from the pharmacy computer;
  - (c) extracting the patient-specific information from the captured data record;
  - (d) generating an advisory message based on the extracted patient-specific information; and
  - (e) transmitting the generated advisory message to a pharmacy printer.
2. The method of claim 1 wherein the step of appending patient-specific information comprises appending any one of a patient greeting, a doctor's appointment reminder, billing information, promotional materials, information concerning related products, information concerning related discounts, government warnings, and news items.
3. The method of claim 1 wherein the step of appending patient-specific information comprises appending the patient-specific information to a data record containing normally transmitted information including any one of a prescription label, dosage information, and information concerning side effects.
4. The method of claim 1 wherein the step of generating an advisory message based on the extracted patient-specific information comprises generating an advisory message in the form of a newsletter.”

Other claims of Byerly et al not disclosed above have also been considered. The Applicant's observations will now be discussed.

- The method of Byerly et al basically comprises “A method for generating advisory messages to pharmacy patients...transmitted between a third party computer and a pharmacy computer during a pharmacy transaction”. The section that the Examiner appears to consider key is contained in dependent claim number two:

“...wherein the step of appending patient-specific information comprises appending any one of a patient greeting, a doctor's appointment reminder, billing information, promotional materials, information concerning related products, information concerning related discounts, government warnings, and news items.”

Here, “a doctor’s appointment reminder” and “billing information” are disclosed side by side as types of “patient-specific information” that is part of a (using the title of the invention) “Method and system for automatically generating advisory information for pharmacy patients along with normally transmitted data” where said advisory information is “...transmitted between a third party computer and a pharmacy computer during a pharmacy transaction”. One must remember, however, that the context in which the “...doctor’s appointment reminder” and “billing information” are presented is in fact a medical or medically related environment.

- The cherished “curveball” of having a medically related health reminder that the Applicant discloses during his discussion of Bucci has no prior disclosure in Byerly et al due to the fact that having “a doctor’s appointment reminder” in a pharmacy situation is tantamount to having an available credit balance over-the-limit reminder in coordination with a credit card offering, in that having “a doctor’s appointment reminder” is congruent with the health related theme of a pharmacy environment.
- Combining “a doctor’s appointment reminder” with “billing information” does not offer the aforementioned Applicant’s “curveball” in that in Byerly et al, “a doctor’s appointment reminder” in a pharmacy environment and “billing information” in a pharmacy environment are not especially surprising (due to the lack of information to the contrary, the Applicant assumes that “billing information” is related to pharmacy matters, and not to matters such as, say, an automobile brake job).
- The disclosure of Byerly et al, as in Bucci, does not teach a consent step on the part of the end user, nor does Byerly et al teach where the end user can select what he receives. The exclusion of each of these two aspects really does not hinder, but rather